

REMARKS

Claims 1 and 56 have been amended by incorporating the subject matter of claim 13 into them. Accordingly, claim 13 has been canceled.

New claim 57 requires the first composition containing the photochromic compound to be a basecoat and the second composition containing the goniochromatic compound to be a topcoat. Support for this new claim exists in the example on pages 42-43.

Claims 1, 2, 4, 7, 9-12, 14-50 and 52-57 are currently pending, although claims 7, 9, 16-18 and 49-54 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants intend to seek rejoinder of withdrawn claims as appropriate.

The Office Action also rejected the pending claims as obvious under 35 U.S.C. § 103 over U.S. patents 6,294,112 (“Clarke”), 6,123,952 (“Lagrange”) and 6,369,147 (“Polonka”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The claimed invention relates to a makeup **kit** comprising two cosmetic compositions, the first composition comprising at least one photochromic compound **in a physiologically acceptable medium**, and the second composition comprising at least goniochromatic compound in a physiologically acceptable medium. The art upon which the Office Action has relied neither teaches nor suggests the claimed invention, or any of these benefits associated with the invention kits.

More specifically, the applied art does not teach or suggest using the claimed photochromic compounds in a cosmetic composition. What’s more, the applied art

does not teach or suggest kits containing two separate compositions, one of which contains a photochromic compound and one of which contains a goniochromatic compound, or any of the benefits associated from combining these two compositions in a kit.

First, none of the applied art teaches or suggests compositions containing the required photochromic compound in a physiologically acceptable medium.

Clarke neither teaches nor suggests cosmetic compositions. More importantly, Clarke neither teaches nor suggests compositions containing at least one photochromic compound in a physiologically acceptable medium as required by the pending claims. Rather, Clarke states that his compounds are useful for incorporation into polymeric hosts to produce non-physiological compositions such as sunglass lenses, ophthalmic lenses, car windows, aircraft windows, etc. (Col. 4, line 30 et seq.). Thus, Clarke provides no motivation whatsoever to produce a composition containing at least one photochromic compound in a physiologically acceptable medium. Instead, Clarke is directed to completely different subject matter.

Lagrange states that his compositions contain thermally irreversible photochromic compounds which are diarylethene derivatives, not naphthopyran compounds. In fact, Lagrange discloses very structurally different photochromic compounds from those of the present invention. Thus, Lagrange neither teaches nor suggests compositions containing the required photochromic compounds in a physiologically acceptable medium.

Polonka discloses goniochromatic compounds. Thus, Polonka neither teaches nor suggests compositions containing the required photochromic compounds in a physiologically acceptable medium.

Clearly, none of the applied art teaches or suggests the required photochromic compounds in a physiologically acceptable medium.

Second, none of the applied art teaches or suggests kits containing two separate compositions, one of which contains a photochromic compound and one of which contains a goniochromatic compound, or any of the benefits associated from combining these two compositions in a kit. To the contrary, all of the applied art is deafeningly silent concerning the use of any materials disclosed therein in cosmetic kits.

This failure to even suggest cosmetic kits is particularly important given (1) the pending claims are directed to kits containing two separate compositions, one of which contains the required photochromic compound and one of which contains the required goniochromatic compound; and (2) the combination of two such compositions results in improved color benefits as described at pages 42-43 of the present application.

Finally, no *prima facie* case of obviousness has been set forth because no motivation to combine the applied art in the required manner to yield the claimed kits would have existed.

Clarke relates to a field other than cosmetics and, thus, would not have been considered when formulating a cosmetic composition. Similarly, Polonka focuses on corrosion resistant pigments useful in painting or coating compositions. (Col. 2, lines

52-54; col. 6, line 48). One of ordinary skill in the cosmetics arts, seeking to produce a cosmetic composition including a physiologically acceptable medium, would not have turned to Clarke and Polonka for guidance. For at least this reason no motivation to combine would have existed.

Moreover, both photochromic compounds and goniochromatic compounds rely upon a light source to achieve their effect. (See, for example, col. 1, lines 7-16 of Polonka). Nothing in any of the applied art would have led one of ordinary skill in the cosmetics art to use these two different types of compounds, both of which were reliant upon a light source to achieve their individual effects, in the same kit -- nothing in the applied art would have suggested the effect that such a combination would have or even whether a useful product could be obtained under such circumstances.

In summary, the present invention requires the presence of a kit containing two separate compositions, one of which contains a photochromic compound and one of which contains a goniochromatic compound. As explained at pages 42-43 of the present application, this combinations yields unique results. The applied art would not have led to the inventive kits of the present application because not only do these references fail to teach or suggest preparing a composition containing the required photochromic compound in a physiologically acceptable medium, but they also are completely silent concerning the presence of cosmetic kits, meaning that they would not have led one of ordinary skill in the art to the claimed kits having the separate compositions or any of the benefits associated with these kits (such as those explained at pages 42-43 of the present application).

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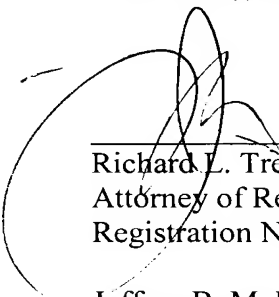
For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejections.

Finally, submitted herewith are a new declaration and Petition under 37 CFR § 1.47(a). Applicants respectfully submit that these filings render moot the objection to the declaration, and that this objection should be withdrawn.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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